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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,798	03/08/2000	Richard Rothkopf	2470-104A	2139

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/520,798

**Applicant(s)**

ROTHKOPF, RICHARD

**Examiner**

James W Myhre

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-21, and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the Board of Patent Appeals and Interferences (BPAI) Decision issued on September 7, 2004, PROSECUTION IS HEREBY REOPENED. New grounds for rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 7-12, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Adams et al (US2003/0083943).

Claims 1 and 10: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site, comprising:

- a. storing a customer identifier for each visitor to the site (page 8, paragraph 0062 and pages 9-10, paragraph 0075);
- b. storing information pertaining to the number of visits to the site <sup>for purchases</sup> by the visitor identified by the customer identifier (page 8, paragraph 0062 and pages 9-10, paragraph 0075);
- c. storing award rules (criteria) for crediting awards to visitors of the site (page 5, paragraph 0049 and page 8, paragraph 0062);
- d. granting an award to a visitor identified by the customer identifier based on the visitor's compliance with the stored award rules (page 8, paragraphs 0062 and 0064).

Claim 2: Adams discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 1 above, and further discloses the award criteria comprising the number of previous visits to the site by that visitor (page 6, paragraph 0054 and page 8, paragraphs 0065-0066).

Claim 3: Adams discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 1 above, and further discloses the award criteria comprising the length of time since the previous visit to the site by the visitor (page 8, paragraphs 0065-0066)

Claims 7, 11, and 12: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 2 and 10 above, and further discloses increasing (or varying) the award value with each successive visit to the site by the visitor (page 5, paragraph 0049 and page 8, paragraphs 0065-0066).

Claims 8 and 16: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above, and further discloses crediting the promotional award (award points) to a purchase price of a purchase by the visitor (page 6, paragraph 0053).

Claims 9 and 18: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above, and further discloses the connecting to the electronic commerce site through the Internet (page 8, paragraph 0062).

Claim 17: Adams discloses a method for offering a promotional award to a visitor of an electronic commerce site as in Claim 10 above, and further discloses the visitor selecting the promotional award (page 8, paragraph 0067).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6, 13, 15, 19, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 2003/0083943) in view of Steinman et al (US 2003/0105663).

Claims 4, 5, 13, 15, and 19: Adams discloses a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 1 and 10 above and further discloses accumulating a total value of awards (page 5, paragraph 0047), but does not explicitly disclose that the current award is determined based on the cumulative value of the previous awards nor that an award limit is set. However, Steinman discloses a similar apparatus for offering a promotional award to a visitor of an electronic commerce site in which the value of the award is determined by the length of time since the previous award or based on the total accumulative value of previous awards and a limit is set for the amount of awards one visitor may be granted during a predetermined time period (e.g. Steinman discloses that the amount of the

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award may be decreased to the difference between the current award total and the award limit for that time period; e.g. 100 point daily limit)(page 3, paragraph 0031).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the value of the current award in Adams on the total accumulated value of previous awards. One would have been motivated to use such a criteria in Adams in order to limit the financial liability of the award issuer. Without such a cap or limit on the amount of awards a visitor may accrue, the award issuer could accumulate millions of dollars in liabilities when a great number of visitors "run up" a large number of awards within a short amount of time.

Claim 6: Adams and Steinman discloses an apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claim 5 above, and Steinman discloses setting an award limit. Adams further discloses the accumulate value of the awards are reduced when the visitor makes a purchase at the site using the award points (page 6, paragraph 0055). While it is not explicitly disclosed that the award limit is set back to zero, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if the visitor redeemed all of his accumulated award points, the award limit would be reset to zero upon the updating of the accumulated awards file. One would have been motivated to reset the award limit in order to allow the visitor to accumulate more awards, thus enticing the visitor to visit the electronic commerce site again in the future.

Claims 20 and 23: Adams and Steinman disclose a method and apparatus for offering a promotional award to a visitor of an electronic commerce site as in Claims 2 and 10 above, and Adams further discloses increasing (or varying) the award value with each successive visit to the site by the visitor (page 5, paragraph 0049 and page 8, paragraphs 0065-0066).

Claim 24: Adams and Steinman disclose a method for offering a promotional award to a visitor of an electronic commerce site as in Claim 10 above, and Adams further discloses the visitor selecting the promotional award (page 8, paragraph 0067).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Slotznick (6,011,537) discloses a method and apparatus for tracking how often a user visits a web site and awards "frequent flyer miles" to the visitor.

b. Ng (6,405,175) discloses a method and apparatus for awarding users for viewing a supplier's web page.

c. Michie (US 2001/0023189) discloses a method and apparatus for tracking the timing and frequency of visits a user makes to a web site and awards prizes according to some predetermined criteria to customers who access the website.

d. Winters (US 2001/0034635) discloses a method and apparatus for awarding miles or points to participants for consumer behavior such as visiting web sites.



e. Barnhart (US 2002/0169672) discloses a method and apparatus for attracting repeat visitors to an online web site by offering awards which change according to the tracked visit information ("based on the number of visits within a predetermined period of time") or a predetermined schedule.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

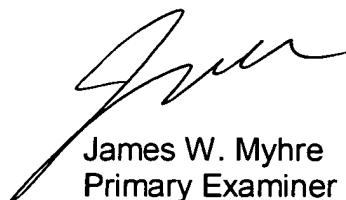
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Note: Effective April 2005, the examiner's telephone numbers will be changed to (571) 272-6722 (phone) and (571) 273-6772 (Informal faxes); and the examiner's supervisor's telephone number will be changed to (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
March 14, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622

JOHN J. LOVE  
DIRECTOR  
TECHNOLOGY CENTER 3600

